



FILE NO. 31064 070165.0447
JUL 31 1998
F5
8/7/98

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Podos et al.

Serial No. : 08/853,803 Examiner: Z. Fay

Filed : May 9, 1997 Group Art Unit: 1614

For : NOVEL PROSTAGLANDINS FOR GLAUCOMA THERAPY

AMENDMENT

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Assistant Commissioner for Patents, Washington, D.C. 20231

July 29, 1998

Date of Deposit

Lisa B. Kole

Attorney Name

A handwritten signature in black ink that reads "Lisa B. Kole".

Signature

35,225

PTO Registration No.

July 29, 1998

Date of Signature

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

In response to the Official Action dated April 29, 1998, please consider the following remarks.

The Examiner has rejected the claims over DeSantis et al., United States Patent No. 5,565,492. According to the Examiner, DeSantis teaches the use of prostaglandin E, its derivatives and analogues for the treatment of glaucoma. The Examiner contends that the claims are obvious under 35 U.S.C. §103 because the compounds of the claims have been used in the treatment of glaucoma and Applicants have shown no evidence of the unexpected and unobvious nature of the claimed subject

matter.

Applicants assert that DeSantis does not render the instant claims obvious because the claimed compounds are structurally different from the compounds taught in DeSantis. Virtually all of the prostaglandins disclosed in DeSantis have an opposite geometrical arrangement of side chains relative to the presently claimed compounds. In particular, with respect to the prostaglandin five-membered ring, the attached side chains are *trans* in all of the compounds disclosed in DeSantis, but *cis* in the instantly claimed compounds (hence the "iso" prefix). In view of this structural difference (which is remarked upon in the instant specification at page 6 lines 7-9 of the specification), the skilled artisan would not have reasonably expected the 8-iso-prostaglandins of the invention to be effective in decreasing intraocular pressure.

Accordingly, Applicants request that the rejection be withdrawn and that the claims be allowed to issue.

Respectfully submitted,



Richard S. Clark
Patent Office Reg. No. 26,154

Lisa B. Kole
Patent Office Reg. No. 35,225
Attorneys for Applicants